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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/579,330

08/08/2006

Minas Theodore Coroneo

20231-006002/Q78501

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10/05/2007

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EXAMINER

WIEST, PHILIP R

ART UNIT

PAPER NUMBER

3761

MAIL DATE

DELIVERY MODE

10/05/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/579,330

Applicant(s)

CORONEO, MINAS THEODORE

Examiner

Phil Wiest

Art Unit

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date See Continuation Sheet.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

Continuation of Attachment(s) 3. Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :5/16/06, 8/8/06, 5/15/07, 9/7/07.

DETAILED ACTION

Claim Objections

1. Claim 19 is objected to because of the following informalities: the terms "inner end" and "outer end" seem to imply that the ends are on the inside and outside of the tube. The examiner recommends that "inner end" is changed to "distal end," and "outer end" is changed to "proximal end." The terms "distal" and "proximal" are standard terms in the art of fluid-transferring shunts. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 19 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Donowitz et al. (US 3,788,327).
4. With respect to Claim 19, Donowitz discloses an ocular pressure spike shunt comprising a fluid transfer tube made from a biocompatible, flexible material (Column 3, Lines 19-23). The tube has an inner (distal) end 38, an outer (proximal) end 40, a tubular lumen disposed therebetween, and a valve 48 for maintaining pressure in the eye at a normal level, said valve opens to permit fluid flow through the tube when a predetermined pressure is exceeded (Column 2, Line 65 through Column 3, Line 2).

When implanted in the eye, the shunt is disposed such that the outer end is substantially flush with the surface of the cornea, and the inner end opens into the anterior chamber of the eye. See Figures 1, 2, and 4.

5. With respect to Claim 21, Donowitz discloses the method of implanting an ocular shunt as described above, comprising forming an incision in the eye, and introducing the shunt (see rejection above) through the incision such that the outer end is flush with the surface of the cornea and the inner surface extends into the anterior chamber of the eye.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Donowitz in view of Brown et al. (US 5,743,868). Donowitz discloses an ocular shunt having a pressure-regulating valve substantially as claimed (see rejection above). Donowitz, however, does not specifically disclose that the valve operates such that a 10 mmHg pressure differential is maintained. Brown discloses an ocular implant for regulating pressure between the anterior chamber and the exterior of the cornea such that the pressure difference is kept at 10 mmHg, which is considered to be a normal pressure in the anterior chamber (Column 6, Lines 37-44). It would have been obvious

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to one of ordinary skill in the art at the time of invention to modify the unidirectional pressure control valve of Donowitz to regulate fluid flow such that a 10 mmHg pressure differential is maintained in order to keep the anterior chamber of the eye at a natural pressure level.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phil Wiest whose telephone number is (571) 272-3235. The examiner can normally be reached on 8:30am-5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, LoAn Thanh can be reached on (571) 272-4966. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


LOAN H. THANH
PRIMARY EXAMINER

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9/20/07